

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DALE SCHULZE

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Appeal No. 96-2192  
Application 08/306,856<sup>1</sup>

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ON BRIEF

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Before THOMAS, BARRETT, and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 2 through 4, 30 and 31, which constitute all the claims remaining in the application.

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<sup>1</sup> Application for patent filed September 15, 1994. According to appellant, the application is a continuation of Application 08/092,734, filed July 14, 1993, now abandoned.

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Representative claim 30 is reproduced below:

30. A device for monitoring the number of times a sterilization has been performed comprising:

a temperature sensitive mechanical element which transforms from a first spatial state to a second spatial state at a predetermined temperature; and

a blocking element coupled to said mechanical element movable from a retracted position to an extended blocking position when the number of heatings of said temperature sensitive mechanical element beyond a predetermined temperature exceed a predetermined number of such heatings; and

said monitoring device capable of blocking operation of a surgical instrument when said blocking element is in said extended position.

There are no references relied on by the examiner.

Claims 2 through 4, 30 and 31 appear to be rejected on the basis of the written description as well as enablement portions of 35 U.S.C. § 112, first paragraph, according to a liberal interpretation of the position advocated by the examiner in the Answer. Only claims 2 through 4 stand rejected under the second paragraph of 35 U.S.C. § 112.

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Rather than repeat the positions of the appellant and the examiner, reference is made to the Briefs and the Answer for the respective details thereof.

#### OPINION

Turning first to the rejection of claims 2 through 4 under the second paragraph of 35 U.S.C. § 112, we reverse this rejection. Although the rejection of these claims was included in the third page of the Final Rejection, Paper No. 15, dated April 28, 1995 for the version of claims 2 through 4 pending at that time, an Amendment accompanying the Reply Brief dated October 19, 1995 amended these claims to remove the questioned antecedent basis language of a "surgical instrument." This Amendment bears an approved for entry indication by the examiner in the uppermost left portion of the Amendment on file. The subsequent communication from the examiner dated November 29, 1995, notes and permits entry of the Reply Brief but is silent with respect to its accompanying

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Amendment to claims 2 through 4. Since the file record does reveal the entry of that Amendment even though it has not been specified by the examiner in this latest communication, we must reverse the rejection because it is clearly apparent that the basis of the rejection is no longer present in pending claims 2 through 4 on appeal.

Turning next to the rejection of claims 2 through 4, 30 and 31 under the first paragraph of 35 U.S.C. § 112, we reverse this rejection as well. Independent claims 30 and 31 contain identical subject matter, with claim 31 including an additional limitation relating to a display device, which latter feature is not the subject of any issue raised by the examiner in the rejection of the claims under the first paragraph of 35 U.S.C.

§ 112. As such and because appellant indicates at the top of page 2 of the principal Brief on appeal that the issues as to this rejection are the same for both independent claims, we take as a representative claim independent claim 30.

The examiner's position makes reference to the written description portion of 35 U.S.C. § 112, first paragraph, at

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the top of page 4 of the Answer as well making reference to the claims not having adequate support in the disclosed invention in the paragraph bridging pages 6 and 7 of the Answer.

The examiner's reasoning for lack of "support" for the claimed invention implicitly refers to the written description requirement of 35 U.S.C. § 112, first paragraph. In re Higbee, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976).

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of later claimed subject matter. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117, reh'g denied (Fed. Cir. July 8, 1991) and reh'g en banc denied (Fed. Cir. July 29, 1991).

The present independent claims 30 and 31 were not initially filed claims. We do, however, observe that originally filed claim 17 related the blocking element to a

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surgical device. Therefore, the concept of a claimed blocking element or device being a part of a surgical device was clearly set forth in original claim 17. See In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

As to the present version of the invention set forth in independent claims 30 and 31, there is no dispute that the record reveals that a blocking element was disclosed in each of Figures 1 and 2 set forth in the specification as the respective first and second embodiments. These include specific discussions with respect to element 40 in Figure 1 and element 74 in Figure 2 functioning as blocking elements in these respective embodiments.

On the other hand, the examiner asserts at the top of page 6 of the Answer that the structure of the overall device in the Figure 3 or third embodiment does not include a blocking element per se to inhibit future use of the surgical instrument specifically disclosed in Figure 3f. Appellant's Brief may be read such as to infer the same and our study of the Figure 3 embodiment leads us to agree with the examiner's

statement. However, as noted by appellant in the Brief, the discussion at the top of page 15 of the original specification, lines 1 through 7, indicates a general teaching that a counter device-blocking element according to the invention may be included in a surgical instrument. This broad or generalized statement at this page of the specification may be interpreted to include the concept of applying it to the Figure 3 embodiment. Therefore, to the extent the examiner's position in the Answer is based upon the written description portion of 35 U.S.C. § 112, the rejection must be reversed. To the extent recited in independent claims 30 and 31 on appeal of a monitoring device being "capable of blocking operation of a surgical instrument," each of the respective embodiments 1 through 3 of the disclosed invention either expressly or by inference taught the concept of a blocking element of some kind functioning in association with a surgical device.

On the other hand, it appears that the examiner's basic underlying issue with respect to the present claims on appeal relates to a surgical instrument being inadequately disclosed

with respect to a blocking element in the three embodiments disclosed, with emphasis on the Figure 3 embodiment. The reasoning in the answer repeatedly asks in different contexts basic "how" questions.

Generally speaking, "[t]he test of enablement is whether one reasonably skilled in the art could make or [sic and] use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

The following portions of the written description portion of the specification as filed relate to a surgical device or instrument: page 2, lines 10 through 24; page 3, line 28 through page 4, line 9; Figure 1, embodiment 1, page 7, line 26 through page 8, line 8; Figure 2, the second embodiment, page 9, line 29 through page 10, line 8; and Figure 3f, part of the third



embodiment, page 5, lines 8 through 10 and page 14, lines 18 through 32, as well as the general assessment at page 15, lines 1 through 7.

From the examiner's perspective, each independent claim recites positively a blocking element. There is, however, only a passive recitation of the overall monitoring device of independent claims 30 and 31 being merely "capable of blocking operation of a surgical instrument." The examiner's position as to the enablement issue appears to be based upon the concern that while on the one hand, the Figures 1 and 2 embodiments appear to specifically teach blocking elements, they only passively teach or suggest their application to a surgical device or instrument, while the Figure 3 embodiment, and specifically the Figure 3f embodiment, specifically relates the counting device of this figure to a surgical instrument or device at the same time it contains no explicit teachings or showings of having the capability of a blocking element.

In the context of the appropriate judicial standard for review of enablement issues being whether the claimed invention would have required the artisan to exercise undue experimentation to make and use the claimed invention, we conclude that no such undue experimentation would have been necessary for the artisan to have either implemented a specific type of surgical instrument with respect to the Figure 1 and 2 embodiments or a specific type of blocking element to the specific type of surgical device set forth in the Figure 3 embodiment. Stated differently, we are of the view that from an artisan's perspective only a reasonable degree of experimentation would have been necessary to have enabled him or her to make and use the claimed invention.

For example, the blocking element is set forth in the summary of the invention in the paragraph bridging pages 3 and 4 of the specification as filed as blocking or inhibiting the use of a whole surgical instrument such as blocking an actuation knob thereof. With respect to the Figure 1 embodiment, the discussion in the paragraph bridging pages 7 and 8 makes specific reference to blocking or locking an

actuation knob of a surgical instrument. Furthermore, in the context of the Figure 3 embodiment as well as the Figure 1 and 2 embodiments, the discussion at the top of page 15 is telling. It appears that this discussion may be read to enhance or modify any and all of the three embodiments in such a manner as to indicate that a counter device or monitoring device of the disclosure may be included in a handle of a surgical instrument and may in any event perform a blocking and counting function by "meeting with the recycled moving shaft of a surgical instrument, as described above." We are of the view that the artisan would have been required to exercise only a reasonable or routine degree of experimentation to have applied the teachings and showings of the Figures 1 and 2 embodiments to the laparoscopic device shown in Figure 3f of the disclosed invention.

In view of the foregoing, we have reversed the rejection of claims 2 through 4 under the second paragraph of 35 U.S.C. § 112. We have also reversed the rejection of claims 2 through 4, 30 and 31 under the first paragraph of 35 U.S.C. § 112. Therefore, the decision of the examiner is reversed.

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REVERSED

	JAMES D. THOMAS	)	
	Administrative Patent Judge	)	
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		)	
	LEE E. BARRETT	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	MICHAEL R. FLEMING	)	
	Administrative Patent Judge	)	

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